

## REMARKS

Reconsideration of the rejections set forth in the Office Action is respectfully requested. Claims 1-23 are now present in the application. Claims 1-11 and 16-23 are withdrawn from further consideration.

### Remarks with respect to all rejections:

The Examiner rejected claims 12 through 15 of the Application as obvious over Lewark in view of Eggiman et al. The Examiner took the position that Lewark discloses all of the steps in the claimed method with the exception of the use of a compression wrap during the curing process. The Examiner stated that Eggiman demonstrates that such a step is known in the art when curing composite bats. Thus, the Examiner concluded that it would have been obvious to have used such a step in curing Lewark's bat to help securely affix Lewark's composite layer.

The applicant respectfully disagrees with the Examiner's position because Eggiman does not disclose nor suggest using such a step to secure or affix a composite layer to the handle portion of a bat or any other underlying substrate. Rather, Eggiman teaches that the use of compression during the curing process will yield a tubular member that may be removed from the underlying substrate upon which the member is formed and cured. Such teaching is exactly opposite the claimed method which contemplates the use of compression during to curing process to bond a tubular overlay to a bat handle such that the overlay becomes integral with the bat and can not be removed.

At § 2143.01 the MPEP states "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Boiled down to its essence, Eggiman teaches that the step of curing under pressure may be useful to bond one layer of composite material to another layer of composite material. For

example, Eggiman discloses wrapping multiple sheets of preimpregnated composite material around a mandrel to form a tubular member (Eggiman, Col. 5, Lines 60-65) then wrapping the tubular member in shrink tape and curing it (Eggiman, Col. 6, Lines 12-30). Although Eggiman does not specifically state that the tubular member is removed from the mandrel before being inserted into the bat, such a step is clearly taught in Eggiman. First, the member is described as “tubular” indicating that the member has a hollow center. Second, the Third College Edition of Webster’s New World Dictionary defines mandrel as “2. [A] metal rod or bar used as a core around which metal, wire, glass, etc. is cast, molded, forged, or shaped.” Thus, the method taught by Eggiman does not secure the multiple layers of composite material to the mandrel. Accordingly, one reasonably skilled in the art would not conclude that Eggiman’s method would be useful for bonding a composite layer to an underlying substrate such as a mandrel or a bat handle.

The fact that Eggiman’s does not teach a method for securing a composite material to the mandrel is critical. The method claimed in the present application is a method for affixing an overlay member to a handle of a bat. Claim 12 of the present application requires “wrapping at least a portion of the bat with a suitable wrapping material to compress the overlay to the bat handle.” Thus, the purpose of the wrapping and compression step in the claimed method is exactly opposite to the teachings of Eggiman. Whereas following Eggiman’s teachings results in a composite tubular insert that may be removed from the mandrel on which the tubular insert was formed, following the teachings of the present application results in an overlay that is bonded to the bat handle so completely that it becomes an integral part of the handle. (*See e.g.* Specification, p. 5 stating “The foregoing procedure eliminates almost 100% of any air bubbles

or voids in the resin matrix and bonds the sleeve to the bat handle completely so that it becomes an integral part of the handle.”).

Thus, the motivation or suggestion identified by the examiner, “to help securely affix Lewark’s composite layer,” is not is not present and one reasonably skilled in the art would not follow Eggiman’s teachings to secure Lewark’s overlay to the bat handle. Accordingly, the proposed combination of Lewark and Eggiman does not make out a proper case of *prima facie* obviousness.

Eggiman does briefly discuss an alternative embodiment wherein the tubular member is secured to the exterior of a bat, however, Eggiman does not teach the method by which the tubular member is secured to the bat. Eggiman, Col. 5 Lines 1-7.

Furthermore, applying the teaching of Eggiman to Lewark would change the principle operation of Eggiman. As described above, the principle of operation of Eggiman is the formation of a tubular member on a mandrel then removal of the tubular member from the mandrel. *See* Eggiman, Col. 5 Line 60 through Col. 6 Line 39. As identified by the Examiner, the compression step in present invention is used to “help securely affix Lewark’s composite layer.” Thus, one would need to change the principle of operation of Eggiman to apply Eggiman’s teachings to arrive at the method claimed in the present application.

MPEP § 2143.01 states “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Accordingly, the proposed combination of Eggiman and Lewark does not make out a proper *prima facie* case of obviousness.

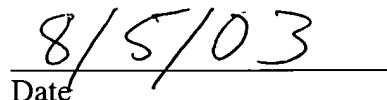
Concluding Remarks

In light of the foregoing, Applicant believes that all of the claims currently pending in the Application are allowable and respectfully asks the Examiner to reconsider the Application. If the Examiner believes that further communication with the Applicant or the Applicant's counsel will be beneficial to the pending Application, the Examiner is invited and encouraged to contact Applicant's counsel directly by telephoning (619) 525-2553.

Respectfully submitted,



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Date